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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,758	10/15/2003	George K. Phillips	VFT-014	8706

23410 7590 10/18/2007
Vista IP Law Group LLP
2040 MAIN STREET, 9TH FLOOR
IRVINE, CA 92614

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/686,758	Applicant(s) PHILLIPS ET AL.	
	Examiner Lawrence D. Ferguson	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,9-11,14-20,22,23,25,28,29 and 32-49 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,3,4,6,9-11,14-20,22,23,25,28,29 and 32-49 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed August 6, 2007.
Claims 1, 11, 20, 29 and 36 were amended, claims 2, 5, 7, 8, 12-13, 21, 24, 26-27 and 30-31 were cancelled and claims 38-49 were added rendering claims 1, 3-4, 6, 9-11, 14-20, 22-23, 25, 28-29 and 32-49 pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections – 35 USC § 102(b)

3. Claims 1, 3-4, 9-11, 15-20, 22-23, 28-29, 33-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips (U.S. 5,772,248).

Phillips discloses a copy resistant security sheet (column 1, lines 8-12 and column 2, lines 34-39) comprising a substrate (11) made of paper, an overlay marker (reflective layer) (10) made of metallic reflective material and a diffusing projected marking (diffusing layer) (16) (column 3, lines 10-36 and column 4, lines 30-35 and Figures 1 and 5). The reflective layer has a reflectance of at least eighty percent (column 3, lines 45-50 and Figure 2). Figure 5 shows the reflective layer is non-black and the reflective elements have a rectilinear structure (column 5, lines 4-25). The image relief structure is a series of alpha-numeric characters to provide informational content to the contrasting visible image, where the latent image is hidden when an

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observer views the sheet at a certain angle (column 2, lines 50-53 and column 3, lines 45-50). Phillips discloses the latent image is formed on the surface of the overlay marker (column 4, lines 46-47). The image structure (18) comprising a light reflecting surface. Phillips discloses the overlay marker comprises ink or toner receptive material (column 6, lines 50-52) as in claim 43. It is inherent that the hidden message (bear information) of Phillips would be unreadable on a document copy. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art.

In claims 38-39, 41-42, 44-45 and 47-48, the phrase, "for allowing the bearer information to be readable on an original document" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Claim Rejections – 35 USC § 103(a)

4. Claims 6, 14, 25, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (U.S. 5,772,248).

Phillips is cited for the same reasons previously discussed, which are incorporated herein and is relied upon for instant claims 1 and 20. Phillips does not

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disclose the reflective layer being disposed over the entirety of the substrate, the reflective elements being curvilinear or the font size of the reflective elements. It would have been an obvious matter of design choice to extend the reflective layer to cover the entire substrate and to change the shape of the reflective elements to curvilinear, since such a change in size and/or shape is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1995).

Response to Arguments

5. Applicant's arguments regarding the rejection made under 35 U.S.C. 102(b) as being anticipated by Phillips (U.S. 5,772,248) has been considered but is unpersuasive. Applicant argues Phillips does not disclose the raised markings would interfere with overprinted bearer information on a copy of a document, rendering the bearer information unreadable on a copy. Phillips discloses a copy resistant security sheet (column 1, lines 8-12 and column 2, lines 34-39) comprising a substrate (11) made of paper, an overlay marker (reflective layer) (10) made of metallic reflective material and a diffusing projected marking (diffusing layer) (16) (column 3, lines 10-36 and column 4, lines 30-35 and Figures 1 and 5). The image relief structure is a series of alpha-numeric characters to provide informational content to the contrasting visible image, where the latent image is hidden when an observer views the sheet at a certain angle (column 2, lines 50-53 and column 3, lines 45-50). Examiner maintains it is inherent that the hidden message (bearer information) of Phillips would be unreadable on a document copy. The claiming of a new use, new function or unknown property which is inherently present in

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the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Applicant further argues the hidden message is not overprinted on the overlay marker. Phillips discloses the latent image is formed on the surface of the overlay marker (column 4, lines 46-47) where the overlay marker comprises ink or toner receptive material (column 6, lines 50-52) as in claim 43.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
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SUPERVISORY PATENT EXAMINER